

Appln. No. 09/593,546
Amendment dated September 2, 2003
Reply to Office Action mailed 5/30/03

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claim 7 remains in this application. Claims 1 through 6 and 8 through 24 have been cancelled. No claims have been withdrawn. No claims have been added in this response.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 through 8 of the Office Action

Claims 7, 15 through 18 and 20 through 22 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Provence (US 5501329) in view of Sherman (US 3856571).

Claim 19 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the combination of Provence and Sherman in view of Lo et al. (US 5054063).

Claims 23 and 24 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the combination of Provence and Sherman in view of Finlayson et al. (US 2595517).

Claims 7 and 15 through 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wachs et al. (US 3169171) in view of Sherman.

Claim 19 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the combination of Wachs and Sherman in view of Lo et al. (US 5054063).

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Claims 20 through 22 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the combination of Wachs and Sherman in view of Zimmermann (US 2593382).

Claims 23 and 24 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over the combination of Wachs, Sherman and Zimmermann in view of Finlayson (US 2595517).

Claims 15 through 24 have been cancelled.

Claim 7 has been amended to include the requirements of claims 22, 23, and 24, such that claim 7 includes all of the limitations of claim 24 as previously presented, with no new requirements inserted or new issues raised.

It is alleged in the Office Action that one of ordinary skill in the art would have found it obvious to "apply the design of Sherman's carrying case to carry sanitation covers, such as Provence's covers or other design of sanitation covers". However, it is noted that the modification of the Provence storage case 40 to incorporate the design of the Sherman contact lens holder, if attempted, would actually make the case of Provence less compact, as the size of the case would basically be doubled to accommodate the cover of Provence individually, if one were to adopt the Sherman teaching of a compartment for each item being stored. It is submitted that by attempting to make the proposed modification of the Provence case, the case would not only become larger but the positioning of the covers would not take advantage of the nestability of the covers and would make that nestability feature of the Provence invention relatively pointless. It is therefore submitted that one of ordinary skill in the art, considering the Provence teaching of a case for the nested covers, would not be motivated by the Sherman teaching of a contact lens holder, to modify the Provence case to include separate spaces for each cover. Further, in response to the assertion in the Office Action that "these products are carried and used

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together everyday by consumers", it is noted that contact lens must always be carried in separately from each other, typically in separate chambers from each other in a wetting fluid. In contrast, the Provence patent clearly teaches the mounting of the covers together for storage and placing the covers together in the case 40. Thus, it is submitted that one of ordinary skill in the art would appreciate that these items present significantly different storage issue, and one would recognize that features of a holder for one would not necessarily work as a cover for the other.

Further, the Office Action alleges that it would have been obvious "to apply the design of Sherman's carrying case to carry sanitation covers, such as Wach's covers or other design of sanitation covers". However, the Wach's reference teaches at col. 1, lines 33 through 35:

The caps will stack compactly one on top of the other with the tabs extending outwardly of the container through the slotted wall.

It is submitted that one of ordinary skill in the art, considering the teaching of Wachs and its container that holds the a plurality of covers "compactly" in a stack would not abandon this contained design for the Sherman configuration which can hold only two items and holds them in a less compact, side by side configuration. Why would one of ordinary skill in the art abandon the advantages of the Wachs container for a design for a contact lens holder when the Wachs design can hold more covers more compactly?

It is therefore submitted that the prior art, and especially the allegedly obvious combination of Provence, Sherman and Finlayson et al. or Wachs, Sherman, Zimmermann and Finlayson set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claim 7.

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Withdrawal of the §103(a) rejections of claim 7 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

KAARDAL & ASSOCIATES, PC

By 
Ivar M. Kaardal (Reg. No. 29,812)
KAARDAL & ASSOCIATES, P.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5802
(605)336-9446 FAX (605)336-1931
e-mail patent@kaardal.com

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